

REMARKS

Claims 53 – 58, 60 – 63, 66 – 71, 105 – 114 and 141 – 204 are pending. Claims 40 – 52 are canceled by this amendment; claims 1 – 39, 59, 64 – 65, 72 – 104 and 115 – 140 were previously canceled. To make the present review easier, the Applicant has attached a clean copy of the pending claims.

The Examiner had previously indicated that the pending claims were allowable, and then withdrew this allowance in the most recent Office Action, indicating that the reason was “newly found prior art.” This new rejection is traversed for the following reasons.

First, as to claims 66, 69, 111, 114, 145 – 146, 171, 176, 181 – 182 and 184, it is submitted that this rejection is in error. The Examiner in fact does not use any “new reference” or new argument, so Applicant submits that the rejection is plainly an oversight or error. In particular:

- (1) Despite the Examiner’s explanation that he is relying on a “new reference,” he has merely rejected claims 66, 69, 111, 114, 145 – 146, 171, 176, 181 – 182 and 184 based solely on the prior Bradshaw reference (U.S. Patent No. 5,835,722). See Office Action mailed September 20, pages 3 - 5, paragraph 9. This set of rejections is particularly puzzling, considering that the Examiner has already indicated on several occasions now that claims 66, 69 are allowable (see e.g., Office Actions of November 18, 2000, paragraph 15, page 32). This allowability has been repeated in the Office Actions since such time. See e.g., Office Action mailed July 3, 2001 page 27, paragraph 14). Accordingly, Applicants believe this is mostly likely simply a minor oversight on the Examiner’s part, and that the “new” rejections of these claims were not intended.¹

¹ In any event, the description of the rejections is also somewhat unintelligible because of some typographical errors so the meaning is unclear (see page 5 of the Office Action, ll. 6+):

“...Claims 66, 69....are directed towards a system for implementing the system found in claims 46, 50, 40 (sic), and 40 (sic), and therefore similarly rejected.”

It should also be noted that this characterization is not accurate (claims 66, 69 depend from a different independent claim) and on this basis, if the Examiner is going to indeed issue a new rejection, Applicants would appreciate some clarification.

(2) Similarly, there IS no “new argument” made based on the new prior art reference against claims 111, 114, 145 – 146, 171, 176, 181 – 182 and 184 in paragraph 9, page 5. The Examiner has merely reversed course, without explanation, based on an old reference. All of these claims were already determined allowable over this same reference in the prior Office Action (see Office Action mailed July 3, 2001, paragraph 14, page 27), and for detailed reasons that were set out in discussions spanning some three years now. Accordingly, the prior responses set out by Applicants are incorporated by reference herein to the extent the Examiner does not acknowledge that the present rejection is in error.

(3) Finally, along the same vein, claims 54 and 58 are rejected in paragraph 9 of the Office Action (see page 5, ll. 4 – 5), again even though they were previously indicated as allowable, and the “new prior art” found by the Examiner is not even applied to such claims. Again, Applicants submit that this is inconsistent with the Office Action itself (which purports to apply such reference) and with the many Office Actions prior to this date. For this reason, Applicant is of the understanding that this is an oversight, and if the Examiner is contending otherwise, the Applicant should be given an opportunity to respond to any new argument.

(4) For the remaining claims, the Examiner cites to a new reference – Duffy (U.S. Patent No. 5,911,043) as supplementing the teachings of the prior references (Bradshaw, Mogilevsky, and Ishikawa) to render the claims obvious. This, again, is plainly in error for several reasons.

(5) First, Duffy, on its face, does not contribute anything new to the wide array of prior art already considered by the Examiner in these proceedings. The use of ratings for documents in connection with Internet filters is simply irrelevant to the pending claims. At a fundamental level, Duffy is teaching nothing more than a more refined version of the Bradshaw system, and the latter’s deficiencies have been pointed out several times.

(6) More importantly, in each instance where the Examiner argues that it “...it would be obvious to a person of ordinary skill in the art ... to have combined the teachings” of such new reference (Duffy) with the prior references, he notably fails to provide any explanation (let alone evidence) of a suggestion or motivation to do so. Nonetheless, merely because

the references can be combined does not mean the claim as a whole is obvious. *See e.g.*, *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957, 43 USPQ2d 1294, 1297 (Fed. Cir. 1997) "It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements." Thus, on its face, the Office Action clearly reveals that the Examiner acknowledges that there is in fact no such evidence, and the rejection should be withdrawn because it is not supported by any evidence of record.

(7) In fact, the Examiner's arguments illustrate that all he has done is merely pick out pieces of the claimed invention in the prior art, using the present disclosure as a blueprint, and this is also insufficient to support a 103 rejection. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

(8) Accordingly, the Examiner seems to have completely skipped and omitted any mention or evidence to indicate why one of skill in the art would bother (let alone be motivated or suggested) to combine Duffy with any of the previous references already considered in these proceedings. Without such evidence, an obviousness rejection is not sustainable for:

- claims 160 – 164 and 166 (paragraph 10, pages 5 - 10);
- claim 165 (paragraph 11, page 10);
- claims 53, 57, 60 – 63, 70 – 71, 105 – 100, 112 – 113, 141 – 144, 147 – 148, 150 – 151, 167 – 170, 172 – 173, 177 – 180, 185 – 192 and 192 – 204 (paragraph 12, pages 10 – 16);
- claim 149 (paragraph 13, pages 16 – 17)
- claims 55 – 56, 67 – 68, 152 – 159, 174 – 175, 183 and 193 (paragraph 14, pages 17 – 23).

(9) Moreover, it should be apparent to the Examiner that Duffy does not cure the underlying deficiencies in Bradshaw. Duffy is also simply an Internet document filter, which acts to restrict user access to documents, after they are already publicly accessible. See, e.g., col. 3, ll. 27+:

“In a particular embodiment, documents 30 comprise information accessible over the Internet....”

(10) In other words, the focus in Duffy (as in Bradshaw) is on restricting access to materials after they are created or posted in a public place, and not on initial distribution before the document is even published. This is a particularly fatal defect, especially as pertains to many of the pending claims noted below. Furthermore, the Examiner again fails to note that Bradshaw, by its own words, is intentionally directed to a system in which the end user is given little or no control over the types of documents and/or types of recipients that can receive particular content. Instead, a supervisor is placed in charge of determining filtering constraints for the entire system, and the users of the same are stuck with whatever rules are imposed. Again, these deficiencies are material to a number of the pending claims noted below. Other of the claims distinguish for a variety of other reasons noted below.

(11) In this respect, therefore, one of skill in the art would be led away from modifying Bradshaw to include the teachings of Duffy, because the latter is specifically intended to provide more control to end users over the rating of documents to be accessed over the Internet. *See e.g.*, US Patent No. 5, 911,043, col. 4, ll. 41 – 48. This is completely contrary to (and incompatible with) the express teachings of Bradshaw. Accordingly, in a situation like this, where the reference teaches away from the claimed combination, a finding of obviousness is again not sustainable. *See In re Grasselli*, 713 F.2d 731, 218 USPQ 769, 779 (Fed. Cir. 1983).

(12) Thus, as regards the pending independent claims, the prior art fails to teach at least the following limitations:

Claim 53: "...a word checking routine executable by a computing device and for checking whether words in an **unpublished electronic text document** should be included in a communication to a particular audience....**controlling an initial dissemination of such document** based on checking said word" (emphasis added)

Claim 61: "...alerting a user to the presence of said word when it is designated as potentially inappropriate; andallowing a user to modify said word in said document when it is designated as potentially inappropriate **before transmitting said document to a third party**" (emphasis added).

Claim 105: "...defining a word as **offensive** by specifying a **first rating value** for a **first status field** associated with said word in an electronic dictionary; and ...**defining a word as potentially inappropriate for communication with an intended recipient of the electronic document** by specifying a **second rating value** for a **second status field** associated with said word in said electronic dictionary, said second rating value being based in part on a consideration of a gender, language use and/or ethnicity of said particular recipient; and... **selecting whether said first status field and/or said second status field in said electronic dictionary** should be used for examining said text words...identifying any context restricted words in the electronic document **before such document is transmitted to said intended recipient** so that said context restricted words can be modified or eliminated." (emphasis added).

Claim 109: "... the word checking software module is configured such that when it is executed by the computer processing device it can perform the following operations: (i) **selecting one or more language filters** based on identifying which of said one or more status fields for said electronic dictionary words is/are to be used for checking words in the document; generating an alert **when said one or more language filters detects a word** that has a rating that indicates it is offensive and/or inappropriate for a corresponding audience; **publication of the electronic document can be controlled** so that when disseminated to third parties it only includes words that do not have a rating that indicates that such word is offensive and/or inappropriate for a

corresponding audience.” (emphasis added).

Claim 141: “... checking the meaning of a word in an electronic document, which electronic document has not been published.... selecting a set of filter words from said one or more electronic dictionaries to be used for checking said word, said set of filter words being based in part on considering an identity of an intended recipient of said electronic document;wherein the electronic document is checked so as to control initial distribution of such electronic document to said intended recipient (emphasis added).

Claim 148: “...A method of checking the meaning of a word in an electronic document, which electronic document has not been published a first dictionary file to be used for electronic documents sent to a first audience, and a second dictionary file to be used for documents sent to a second audience.... selecting a set of filter words based in part on considering an identity of an intended recipient of said electronic document examining said first and second ratings in said set of filter words.... wherein the electronic document is checked so as to control initial distribution of such electronic document to said intended recipient.” (emphasis added).

Claims 167 and 178 should be allowable for the same reasons.

Claim 152: “... A method of permitting an author of an electronic document to simultaneously check both the spelling and meaning of words when said word has been designated as offensive and/or potentially inappropriate, presenting a second list of alternative words to said author as replacements for said word, and permitting said author to select a second replacement word for said word.” (emphasis added).

Claim 158: “... A method of permitting an author of an electronic document to simultaneously check both the spelling and meaning of words ... determining whether the meaning of said word or replacement word has a designation as offensive and/or potentially inappropriate for use in a text document, said designation being modifiable by the author; and ... when said word has been designated as offensive and/or potentially inappropriate, presenting a second list of alternative words to said author as replacements for said word, and permitting said author to select a second replacement word for said word” (emphasis added).

Claim 159: "... A method of permitting an author of an electronic document to simultaneously check both the spelling and meaning of words in such document wherein said word has a **first meaning in a first context** identified as a first rating in a first dictionary file for a **first audience**, and a **second meaning in a second context** identified as a second rating in a second dictionary file for a **second audience**; and ..examining said **first and second ratings**, said designation being modifiable by the author; and ... **presenting a second list of alternative words** to said author as replacements for said word."

Claim 160: "... locating offensive and/or potentially inappropriate words in said document during the **idle editing periods**....**modifying a word filter electronic dictionary** containing said offensive and/or potentially inappropriate words **based on input from the user** **permitting a user to specify a rating threshold** which must be exceeded in order for said word to be identified as offensive and/or potentially inappropriate." (emphasis added).

Claim 161: "... A method of automatically word checking an electronic document as it is generated by a user and before such electronic document is published.... **allowing the user to specify one or more word filter dictionaries to be used** for filtering text content of the document, where at least one of said one or more word filter dictionaries is selected based on an intended audience for the electronic document.... wherein a result of said word checking is communicated to the user while the user is still entering said text content of the document so that the **electronic document is checked before it is disseminated to said intended recipient** and so as to control initial distribution of such electronic document." (emphasis added).

Claim 166 is allowable for substantially the same reasons.

Claim 179: " determining with a **first electronic language filter** whether said word has a particular meaning that is likely to be offensive to persons intended to read such document; and determining with a **second electronic language filter** whether said word is potentially inappropriate for use in communications to said persons, **based in part on considering an identity of said persons**; and **configuring said first and second language filters** by changing a value of one or more status fields for such words in an electronic dictionary" (emphasis added).

Claim 186: “... **A method of checking content of an unpublished electronic document**... specifying a **language filter** to be used for inspecting words of the electronic document to determine if it contains potentially inappropriate content, said **language filter** being **based in part on an identity of an intended recipient of the electronic document**.... specifying a **language sensitivity threshold level** to be used when evaluating the electronic document....providing an output indicating when said language sensitivity threshold is exceeded based on words in the electronic document **so as to control initial distribution of such electronic document to said intended recipient.**” (emphasis added).

Claim 189: “... **A system for checking content of an unpublished electronic document** **a language filter**... associated with a set of words that are potentially inappropriate for use with a **corresponding recipient of the electronic document**; and specifying said language filter for checking the electronic document; providing an output ... **so as to control initial distribution of such electronic document to said intended recipient**” (emphasis added).

Claim 192: “... **A method of controlling distribution of an electronic document to prevent dissemination of embarrassing and/or harmful content in such electronic document**, ... **identifying offensive words** that should not be included in an electronic document to be distributed to an intended third party recipient; and ... **identifying potentially inappropriate words** said potentially inappropriate words being **based in part on a consideration of an identity of said intended third party recipient** **inspecting the document electronically before it is distributed to said intended third party recipient** ... wherein a status field rating for said offensive words and said potentially inappropriate words **are set up by an author of the electronic document** as part of an electronic language filter.” (emphasis added).

Claim 195: “.... **A method of checking content of an electronic document which has not been published** **configuring a language filter** to be used for inspecting content of the electronic document to determine if it contains potentially inappropriate text, said language filter **being configured based in part on an identity of intended recipients** of the electronic document... **generating an output** ... so that the electronic document is checked before it is disseminated to said intended recipients and so as to control initial publication of such electronic document....” (emphasis added).

Claim 197: "A system for checking content of an electronic document, which electronic document has not been published.... a configurable language filter,based in part on an identity of an intended recipient of the electronic document; wherein said configurable language filter includes a **first language filter** and a **second language filter**using said configurable language filter to check words used in the document wherein initial dissemination of the electronic document can be controlled based on whether the content is appropriate for an intended audience of such electronic document." (emphasis added).

Claim 199: "... a language filter consisting of a **first language filter** and a **second language filter**, said first language filter being associated with words that are potentially inappropriate for use in connection with a **first group of persons**, and said second language filter being associated with words that are potentially inappropriate for use in connection with a **second group of persons** selecting either or both of said first and second language filters for checking words in the document based in part on an identity of an intended recipient of the electronic document (emphasis added).

Claim 201: "... A method of checking content of electronic documents retrieving a word from a first electronic document; and inspecting said word with a language filter selected for the first electronic document, said language filter consisting of either or both of a first language filter and/or a second language filter, said **first language filter** being associated with words that are potentially inappropriate for use in connection with a **first group of persons**, and said **second language filter** being associated with words that are potentially inappropriate for use in connection with a **second group of persons**....identifying whether said word falls within said first language filter and/or said second language filter; andrepeating steps for a second electronic document, wherein a language filter selected for the second electronic document can be varied from that used for said first electronic document ..." (emphasis added).

Claim 203: "... A system for checking content of electronic documents including... a language filter comprised of a **first language filter** and a **second language filter**, said first language filter being associated with words that are potentially inappropriate for use in connection with a **first group of persons**, and said second language filter being associated with words that are potentially inappropriate for use in connection with a **second group of persons** selecting

either or both of said first and second language filters as said language filter such that said first language filter can be used when said electronic document is a first type of document to be disseminated to said first group of persons, while said second language filter can be used when said electronic document is a second type of document to be disseminated to said second group of persons.... **wherein dissemination of said electronic documents, including both said first type of documents and said second type of documents, can be controlled based on whether the content therein is appropriate for an intended audience, including said first and second groups of persons”** (emphasis added).

To the extent the Examiner argues that the dependent claims do not distinguish already over the prior art, the Applicants incorporate by reference the many prior submissions made on these points.

CONCLUSION

The claims are believed to be allowable over the prior art of record for the reasons set out above. It is particularly noted that the newly found reference is not sufficient to cure the many deficiencies in the underlying references, and furthermore, the Examiner has not cited any instance of motivation or suggestion to combine the disparate references. The various claims distinguish over such references for a variety of different reasons. Thus Applicants submit that the present § 103 rejections should be withdrawn.

A petition and fee is enclosed to cover the cost of a two month extension of time to respond to the Office Action.

Should the Examiner believe it that it would be helpful to discuss any of the above points in person, Applicant is open to a telephone conference (415-551-8298) at any convenient time.

Respectfully submitted,



Date: February 20, 2002

J. Nicholas Gross, Attorney, Reg. No. 34,175

I hereby certify that the foregoing is being deposited with the U.S. Postal Service, postage prepaid, to the Commissioner of Patents and Trademarks, this 20thth day of February 2002